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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,157	11/16/2001	Avi J. Ashkenazi	P2730P1C51	4038

35489 7590 10/25/2004

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EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,157

Applicant(s)

ASHKENAZI ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 119-126, 129-131 and 135-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 124-126, 129-131, 135-138 is/are allowed.
- 6) ☒ Claim(s) 119-123, 139-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 02-22-04
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Formal Matters

In the Office Action mailed 10/8/2004, it was not clear in the body of the Action that the Action was made Final. This supplemental Action, while otherwise identical to the previous Action, has been clarified to indicate that it is Final. Applicant's attorney was notified of this Supplemental Action in a telephone call on 10/22/2004. The Examiner regrets the inconvenience. Claims 119-126, 129-131, 135-145 are pending and under consideration.

Information Disclosure Statement

The Information Disclosure Statement submitted 8/4/2004 has been considered, and an initialed copy is attached.

Response to Amendment

Applicant's amendment and arguments filed 8/4/2004 have been fully considered but they are persuasive in part.

The objections to the Specification for a non-descriptive title and use of embedded hyperlinks, have been obviated by Applicant's amendment and are thus withdrawn.

The rejection of claims 124-126, 129-131, 135-138 under 35 U.S.C. 112, first paragraph, as lacking enablement has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 124-126, 129-131, 135-138 under 35 U.S.C. 112, first paragraph, as lacking written description has been obviated by Applicant's amendment and is thus withdrawn.

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The rejection of pending claims 119-122, 135-138 under 35 U.S.C. 102(a) as being anticipated by Aggarwal et al. (2001), has been obviated by the priority showing and is thus withdrawn.

The rejection of pending claims 119, 135-138 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiedemann et al. (2000), has been obviated by the priority showing and is thus withdrawn.

Remaining issues are set forth below.

Claim Rejections - 35 USC § 112 first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 119-123 stand rejected, and new claims 139-145 are rejected, under 35 U.S.C. 112, first paragraph, because the specification, which is enabling for a nucleic acid encoding a full length PRO943 protein of SEQ ID NO: 119, or a nucleic acid of SEQ ID NO: 118, does not reasonably provide enablement for a nucleic acid at least 80-99% identical to SEQ ID NO: 118, or a nucleic acid at least 80-99% identical to a nucleic acid encoding SEQ ID NO: 119, or a nucleic acid of at least 20-100 nucleotides in length which hybridizes to SEQ ID NO: 118, for reasons of record set forth on in Office Action of 4/6/2004. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The rejection of record set forth that claims 119-123, 139-145 are overly broad since insufficient guidance is provided as to which of the myriad of nucleic acids encode variant

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polypeptides which will retain the characteristics of PRO943. However, Applicants do not disclose any actual or prophetic examples on expected performance parameters of any of the possible muteins of PRO943. It is known in the art that even single amino acid changes or differences in the amino acid sequence of a protein can have dramatic effects on the protein's function. For example, As an example of the unpredictable effects of mutations on protein function, Mickle et al. teaches that cystic fibrosis is an autosomal recessive disorder caused by abnormal function of a chloride channel, referred to as the cystic fibrosis transmembrane conductance regulator (CFTR) (page 597). Several mutations can cause CF, including the G551D mutation. In this mutation a glycine replaces the aspartic acid at position 551, giving rise to the CF phenotype. In the most common CF mutation, delta-F508, a single phenylalanine is deleted at position 508, giving rise to the CF phenotype. Thus showing that even the substitution or deletion of a single amino acid in the entire 1480 amino acid CFTR protein sequence can have dramatic and unpredictable effects on the function of the protein. Additionally, it is known in the art that even a single amino acid change in a protein's sequence can drastically affect the structure of the protein and the architecture of an entire cell. For example, Voet et al. (1990) teaches that a single Glu to Val substitution in the beta subunit of hemoglobin causes the hemoglobin molecules to associate with one another in such a manner that, in homozygous individuals, erythrocytes are altered from their normal discoid shape and assume the sickle shape characteristic of sickle-cell anemia, causing hemolytic anemia and blood flow blockages (pages 126-128, section 6-3A and page 230, column 2, first paragraph). Additionally, Yan et al. teaches that in certain cases, a change of two-amino acid residues in a protein results in switching the binding of the protein from one receptor to another (Yan et al., Two-amino acid molecular

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switch in an epithelial morphogen that regulates binding to two distinct receptors. *Science* 290: 523-527, 2000). Since the claims encompass nucleic acids encoding variant polypeptides and given the art recognized unpredictability of the effect of mutations on protein function, it would require undue experimentation to make and use the claimed invention. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. While the Specification discloses that the encoded polypeptide functions in the chondrocyte re-differentiation assay, the claims do not set forth a functional limitation for the nucleic acids encoding the variant polypeptides and since the amino acid sequence of a polypeptide determines its structural and functional properties, and the predictability of which amino acids can be substituted is extremely complex and outside the realm of routine experimentation, because accurate predictions of a polypeptide's structure from mere sequence data are limited. Since detailed information regarding the structural and functional requirements of the polynucleotide and the encoded polypeptide are lacking, it is unpredictable as to which variations, if any, meet the limitations of the claims.

Applicant has added the limitation wherein the nucleic acid is amplified in lung or colon tumors, and argues that based on the detailed description of the cloning and expression of nucleic acid variants of PRO943 in the specification, the description of the gene amplification assay and description of testing the ability of test variant polypeptides in the assay, the actual reduction to practice of sequence SEQ ID NO: 119 and the functional recitation in the instant claims, Applicants submit that one of skilled in the art would know how to make and use the claimed variants, as a lung or colon tumor marker. However, the Specification only shows that the full-

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length nucleic acid of SEQ ID NO: 118 will serve as a marker for lung and colon cancer tumors, while the claims encompass variant nucleic acids. There are a large number of nucleic acid species encompassed by the claims, however, the Specification does not disclose the critical nucleic acid residues necessary to maintain the function of detecting lung or colon tumors. The specification does not disclose the correlation between the structure (sequence) of the encompassed nucleic acids and the function of detecting lung or colon tumors. The nucleic acid sequence determines its structural and functional properties, and predictability of which nucleic acids can be substituted is extremely complex and well outside the realm of routine experimentation, because accurate predictions of a polypeptide's structure from mere sequence data are limited. Since detailed information regarding the structural and functional requirements of the nucleic acids are lacking, it is unpredictable as to which variations, if any, meet the limitations of the claims. Therefore it would require undue experimentation by one of skill in the art to make and use the invention as claimed without further guidance from the instant specification.

Claims 119-123 stand rejected, and new claims 139-145 are rejected, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record set forth in the Office Action of 4/6/2004. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

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The rejection of record set forth that the claims are drawn to nucleic acids at least 80-99% identical to SEQ ID NO: 118, or nucleic acids at least 80-99% identical to a nucleic acid encoding SEQ ID NO: 119, or a nucleic acid of at least 20-100 nucleotides in length which hybridizes to SEQ ID NO: 118 and are thus genus claims. The specification and claim do not indicate what distinguishing attributes shared by the members of the genus. The specification and claims do not place any limit on the number of amino acid substitutions, deletions, insertions and/or additions that may be made to the encoded PRO943 variants. Thus, the scope of the claim includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. The specification and claim do not provide any guidance as to what changes should be made. Structural features that could distinguish compounds in the genus from others in the nucleic acid class are missing from the disclosure. No common structural attributes identify the members of the genus. The general knowledge and level of skill in the art do not supplement the omitted description because specific, not general, guidance is what is needed. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, SEQ ID NO: 118 encoding SEQ ID NO: 119 is insufficient to describe the genus. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between structure and function structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed

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genus. In the instant case, the specification fails to provide sufficient descriptive information, such as definitive structural or functional features of the genus of polynucleotides. There is no description of the conserved regions which are critical to the structure and function of the genus claimed. There is no description of the sites at which variability may be tolerated and there is no information regarding the relation of structure to function. Furthermore, the prior art does not provide compensatory structural or correlative teachings sufficient to enable one of skill to isolate and identify the polynucleotides and polypeptides encompassed. Thus, no identifying characteristics or properties of the instant polypeptides are provided such that one of skill would be able to predictably identify the encompassed molecules as being identical to those instantly claimed. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

Applicant has added the limitation wherein the nucleic acid is amplified in lung or colon tumors, and argues that based on the detailed description of the cloning and expression of variants of PRO943 in the specification, the description of the gene amplification assay and description of testing the ability of test variant polypeptides in the assay, the actual reduction to practice of sequences SEQ ID NO: 118 and the functional recitation in the instant claims, Applicants submit that one of skilled in the art would know that Applicants possessed the invention as claimed in the instant claims.

However, the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant identifying characteristics, i.e.

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structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between structure and function , or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. In the instant case, the specification fails to provide sufficient descriptive information, such as functional characteristics coupled with a known or disclosed correlation between structure and function of the claimed genus of polynucleotides. There is no description of the conserved regions which are critical to the structure and function of the genus claimed. There is no description of the sites at which variability may be tolerated and there is no information regarding the relation of structure to function. Furthermore, the prior art does not provide compensatory structural or correlative teachings sufficient to enable one of skill to isolate and identify the polynucleotides encompassed which have the claimed function. Thus, no identifying characteristics or properties of the instant polynucleotides are provided such that one of skill would be able to predictably identify the encompassed molecules as being identical to those instantly claimed.

Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, the disclosure of SEQ ID NO: 118 is insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus as broadly claimed.

Conclusion

Claims 119-123, 139-145 are rejected.

Claims 124-126, 129-131, 135-138 are allowable.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Advisory Information

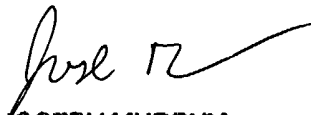
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
October 14, 2004



JOSEPH MURPHY
PATENT EXAMINER